

DETAILED ACTION

Status of Application

1. Claims 9-28 are pending.
2. Receipt and consideration of Applicants remarks/arguments submitted on July 30, 2007 is acknowledged.
3. Rejections not reiterated from the previous Office Action are hereby withdrawn.

The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 9-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15-33 of copending Application No. 10/581109.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a method for the protection of a seed comprising contacting the seeds with a compound of formula I.

Claims 15-33 of copending Application No. 10/581109 are drawn to a method for controlling non-crop pests comprising contacting the pests or food supply, habitat, breeding grounds or their locus with a compound of formula I.

The instant claims differ from the cited patent by reciting a different method of use. However, the method for controlling non-crop pests in copending Application comprises contacting the food supply or breeding grounds with a compound of formula I, and thus is not patentably distinct from the instant claims because the food supply or breeding ground can include the seeds of the instant invention. Thus, it would have been obvious to one of ordinary skill at the time of the invention to apply the compounds of formula I to seeds since the compounds of formula I can be applied to the food supply or breeding grounds where seeds may be present. Therefore, both applications are directed to similar subject matter wherein both methods utilize the compounds of formula I.

Response to Arguments

Applicant's arguments filed July 30, 2008 have been fully considered but they are not persuasive.

Applicant argues that it would not be obvious to use a non-crop pesticide on seeds used in agriculture. Applicant further argues that the office action does not provide rationale underpinning as to why non-crop pests would be a pest found on seeds.

This argument is not persuasive. As discussed above in the previous office action, the compounds of copending application 10/581109 are applied to non-crop pests, their habitat, breeding grounds or locus. Since the breeding grounds encompass grounds where seeds may be present, the two applications are not patentably distinct.

Therefore, the provisional obviousness-type double patenting rejection is maintained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

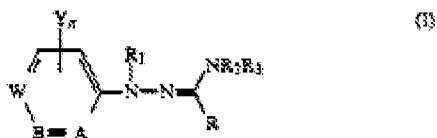
7. Claims 9-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furch et al. (US 5,420,165) in view of Nakagami et al (US 4,304,778).

Applicant claims a method for the protection of seed comprising contacting the seeds before sowing and/or after pregermination with a compound of formula I.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Furch et al. teach the method of applying substituted acid amide, arylhydrazone compounds (amidrazones) to plants or soil or water in which they are growing (see column 5 lines 20-29). The substituted acid amide, arylhydrazone compounds (amidrazones) of formula I



are efficacious insecticidal and acaricidal agents that are useful against Coleoptera, Lepidoptera and Acarina (see the abstract, column 1 lines 20-68, column 2 lines 1-65, column 3 lines 1-24 and 49-52). The compounds are effective for protecting growing or harvested crops (see column 5 lines 20-29). The compounds are generally applied at a

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rate of 0.125 kg/ha to about 250 kg/ha and lower or higher rates may be used depending on the stage of plant growth, soil conditions, etc. (see column 5 lines 32-41). The compounds can be used in conjunction with other chemical control agents such as insecticides, acaricides, (see column 5 lines 43-49).

**Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)**

Furch et al. do not teach contacting a seed with a compound of formula I. This deficiency is cured by the teachings of Nakagami et al.

Nakagami et al. teach a method of protecting growing plants and seeds against insect or mite attack by applying to the seeds, plants or soil, compounds having insecticidal and acaricidal properties (see the abstract and column 2 lines 1-5). The compounds may be applied by foliage spraying, soil drenching or by coating the seeds with the insecticidal and acaricidal compounds (see column 8 lines 30-37).

**Finding of prima facie obviousness
Rational and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the compounds of formula I to a seed.

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One of ordinary skill in the art would have been motivated to do this because Furch et al. suggest the instant compounds for application to soil and plants. Although Furch et al. do not specifically teach applying the instant compounds to seeds, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the instant compounds to seeds because it is already known in the art to apply insecticidal and acaricidal compounds to seeds as well as to soil or plants for protection against insects and mites as suggested by Nakagami et al. Thus, one of ordinary skill in the art at the time of the invention would have applied the instant compounds to any area that may be affected by insect or mite infestation for the purpose of obtaining maximal protection against said pests. Therefore, the claimed method would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed method.

Response to Arguments

Applicant's arguments filed July 30, 2008 have been fully considered but they are not persuasive.

Applicant argues that there is no suggestion that the compounds taught by Nakagami et al. protect seeds against pests. Applicant further argues that when the compounds are used on seeds, it is only to control infections diseases.

This argument is not persuasive. It should be noted that the compounds taught by Nakagami et al. are effective against insect and mite attacks (pests) by applying the compounds to seeds, plants or soil (see column 2 lines 1-5). Although Nakagami et al.

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do mention that the compounds are effective at treating infectious diseases, the compounds are still taught to be useful for seeds, against insect or mite attack.

Next, Applicant argues that even if Furch et al. and Nakagami et al. are combined, there would have been no reasonable expectation of success in arriving at the present method.

Applicant's arguments are not convincing. Furch et al. teach the compounds of formula I are useful for the protection of crops from damage caused by insect and acarid pests (see the abstract and column 1 lines 13-16). Furch et al. do not teach application to seeds, however, it is known in the art to apply insecticidal and acaricidal compounds to seeds as well as plants as suggested by Nakagami et al. Thus, it would have been obvious to try the instant compounds on seeds, since it is already known in the art do so, and there would have been a reasonable expectation of success since insecticidal and acaricidal compounds are known to protect seeds against insects and mites.

Therefore, Applicants arguments of nonobviousness are not persuasive and the rejection is maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIE L. BROOKS whose telephone number is (571)272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616